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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,007	11/13/2003	Hideki Ohmae	2003-1658	6532

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EXAMINER

NEGRON, ISMAEL

ART UNIT PAPER NUMBER

2875

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/706,007	Applicant(s) OHMAE ET AL.	
	Examiner Ismael Negron	Art Unit 2875	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: 3, 8, 9 and 12.
Claim(s) rejected: 1, 2, 4-7, 10, 11 and 13.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached Response to Arguments.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Response to Arguments

1. Applicant's arguments filed July 5, 2005 have been fully considered but they are not persuasive.
2. Regarding the Examiner's rejection of Claim 1 under 35 U.S.C. 103(a) as being unpatentable over HUANG et al. (U.S. Pat. 5,467,146) and TOMITA (U.S. Pat. 5,379,083), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically shading means having a opening, or a spatial light modulator (SLM) driving means for driving an SLM to display black during a period in which light which has passed through an opening of the shading means has passed through two adjacent color filters and contains two colors. In addition, the applicant argues that the cited references could not be physically combined to disclose, or suggest, the claimed invention.
3. Regarding the Examiner's rejection of claims 2, 4-7, 10, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over HUANG et al. (U.S. Pat. 5,467,146) and TOMITA (U.S. Pat. 5,379,083), the applicant present no arguments, except stating that such claims depend directly or indirectly from independent Claim 1 and would be allowable when/if the independent claim is allowed.
4. In response to applicant's arguments that HUANG et al. failed to disclose shading means having a opening, the applicant is respectfully advised that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871

Art Unit: 2875

(CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, while it might be argued that the shading means 26 of HUANG et al. lack the claimed opening, it is noted that the rejection was based on the combination of HUANG et al. and TOMITA. As stated in Section 2 (page 8) of the previous Office Action (Paper No. 20050328), one of ordinary skill in the art at the time the claimed invention was made would have found it obvious to include the adjustable aperture shading means of TOMITA in the illumination device of HUANG et al., to adjust the size and brightness of the projected image, as per the teachings of TOMITA.

5. In response to applicant's arguments that HUANG et al. failed to disclose a spatial light modulator (SLM) driving means for driving an SLM to display black during a period in which light which has passed through an opening of the shading means has passed through two adjacent color filters and contains two colors, the applicant is respectfully advised that, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). In this case, as admitted by the applicant HUANG et al. discloses a SLM 15. One of ordinary skill in the art would have recognized that HUANG et al. inherently included SLM driving means, as such means are necessary for the operation of the SLM. As to the SLM driving means of HUANG et al. not being for performing the claimed function of displaying black during a period in which light which has passed through an opening of the shading means has passed through two adjacent

Art Unit: 2875

color filters and contains two colors, the applicant is advised that the SLM of HUANG et al. was considered capable of performing such function and as such was considered to meet the "for displaying black" recitation.

If it is applicant's intention to claimed the disputed function as one necessarily performed (instead of merely one of the possible uses of the patented structure of HUANG et al.) the Examiner respectfully suggest amending the claim language to read: "a spatial light modulator driving means; ~~for driving the spatial light modulator to display~~ displaying black during a period in which light which has passed through the opening has passed through two adjacent color filters and contains two colors."

6. In response to applicant's argument that the cited references could not be physically combined to disclose the claimed invention, the applicant is respectfully advised that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, one of ordinary skill in the art at the time the claimed invention was made would have found it obvious to include the adjustable aperture shading means of TOMITA in the illumination device of HUANG et al., to adjust the size and brightness of the projected image, as per the teachings of TOMITA (as stated in Section 2, page 8, of the previous Office Action).

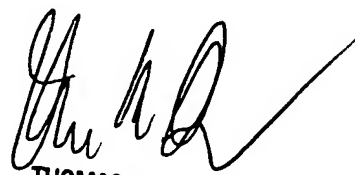
Art Unit: 2875

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.


THOMAS M. SEMBER
PRIMARY EXAMINER


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July 25, 2005